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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
LIN, KENNY S				
ART UNIT		PAPER NUMBER		
2452				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

09/528,363

Applicant(s)

NG ET AL.

Examiner

KENNY S. LIN

Art Unit

2452

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 31-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 31-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-8 and 31-46 are presented for examination. Claims 9-30 are canceled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. The term "start criteria" in the last paragraph of the "providing start criteria for..." sentence renders the claim indefinite since it is uncertain whether this "start criteria" is the "start criteria stored on the client personal computer" or "the start criteria of the server". Especially it is uncertain which device is performing the claimed method steps.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8 and 31-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan et al (hereinafter Narasimhan), US Patent 6,073,165, in view of Moon et al (hereinafter Moon), US Patent 6,138,146, and Pivowar et al (Pivowar), US 6,457,062.
6. Narasimhan and Moon were cited in the previous office action.
7. As per claims 1-2, Narasimhan taught the invention substantially as claimed including a method of forwarding email, comprising:
- a. examining start criteria (col.1, lines 46-49, col.2, lines 3-6, col.5, lines 3-35; e.g. filter and forwarding parameters);
 - b. determining whether the start criteria are met (col.5, lines 18-40); and
 - c. obtaining new email events from an email datastore when the start criteria are met (col.4, lines 6-11, col.5, lines 37-40, 50-60, col.6, lines 3-6, 11-21, 40-56).
 - d. forward information corresponding to the new email events via a computer network to a datastore associated with the server (col.4, lines 6-11, 44-54, col.5, lines 3-17, col.6, lines 11-21, 40-56).
8. Narasimhan did not specifically teach the method is instructed by an email forwarding engine downloaded from a server computer to a client personal computer and the steps of comparing the start criteria stored on the client personal computer with start criteria stored on the server; and synchronizing the start criteria stored on the client personal computer and the start criteria stored on the server when a difference is detected there between. However, it would

have been obvious to download software and implement the system with an email forwarding application. Moon taught to forward the forwarded information to a remote device (col.2, lines 22-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon and implement the mail forwarding program to both the client computer and the servers to provide the functions of filtering and forwarding all incoming emails.

9. Narasimhan and Moon did not specifically teach to provide start criteria for comparison with start criteria stored on the client personal computer, wherein the start criteria of the client personal computer is synchronized to the start criteria of the server when a difference is detected there between. Pivowar disclosed a method for comparing information of the client and the sever and to synchronized the information when a difference is detected (col.1, lines 29-32, 36-42, col.5, lines 5-24, 40-52, col.10, lines 13-17, 36-41, col.12, lines 3-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan, Moon and Pivowar because Pivowar's teaching of synchronizing information and conflict resolution enables Narasimhan and Moon's method to ensure the system to have a set of completely updated information (see Pivowar: col.1, lines 56-62).

10. As per claims 3-4, Narasimhan taught the claimed invention including a method of forwarding email, comprising:

- e. Establishing a communication channel between a server and with a client personal computer system (col.1, lines 40-43, col.2, lines 50-65, col.3, lines 39-44);

- f. Receiving information corresponding to new email events from the client computer system (col.4, lines 6-11, col.6, lines 11-21, 40-56); and
- g. Storing the information corresponding to the new email events in a datastore associated with the server (col.4, lines 6-11, 44-54, col.6, lines 11-21, 40-56).

11. Narasimhan did not specifically teach the method is instructed by an email forwarding engine downloaded from a server computer system to a client personal computer and to forward the information to an appropriate client personal computer. However, it would have been obvious to download software and implement the server with an email forwarding application to forward the incoming email events to another device. Moon taught to forward the forwarded information to a remote device (col.2, lines 22-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon and implement the mail forwarding program to both the client computer and the servers to provide the functions of filtering and forwarding all incoming emails.

12. Narasimhan and Moon did not specifically teach to provide start criteria for comparison with start criteria stored on the client personal computer, wherein the start criteria of the client personal computer is synchronized to the start criteria of the server when a difference is detected there between. Pivowar disclosed a method for comparing information of the client and the sever and to synchronized the information when a difference is detected (col.1, lines 29-32, 36-42, col.5, lines 5-24, 40-52, col.10, lines 13-17, 36-41, col.12, lines 3-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the

teachings of Narasimhan, Moon and Pivowar because Pivowar's teaching of synchronizing information and conflict resolution enables Narasimhan and Moon's method to ensure the system to have a set of completely updated information (see Pivowar: col.1, lines 56-62).

13. As per claims 5-6, Narasimhan taught the claimed invention including a method of forwarding email, comprising:

- h. Obtaining filter control data (col.1, lines 46-49, col.2, lines 3-6);
- i. Examining email data against the filter control data (col.5, lines 3-17);
- j. Determine the email data that will be forwarded based on the examination (col.5, lines 3-40);
- k. Selecting at least one transfer protocol for the email data based on the examination (col.5, lines 18-26, 37-49, col.6, lines 40-56, col.7, lines 39-45); and
- l. Forwarding the email data according to the at least one transfer protocol via a computer network to a datastore associated with the server (col.4, lines 44-54, col.6, lines 19-21, 40-56).

14. Narasimhan did not specifically teach the method is instructed by an email forwarding engine downloaded from a server computer system to a client personal computer and the steps of comparing the filter control data stored on the client personal computer with filter control data stored on the server at predetermined time intervals; and synchronizing the filter control data stored on the client personal computer to the filter control data stored on the server when a difference is detected between there between. However, it would have been obvious to

download software and implement the server with an email forwarding application to forward the incoming email events to another device. Moon taught to forward the forwarded information to a remote device (col.2, lines 22-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon and implement the mail forwarding program to both the client computer and the servers to provide the functions of filtering and forwarding all incoming emails.

15. Narasimhan and Moon did not specifically teach the steps of comparing the filter control data stored on the client personal computer with filter control data stored on the server at predetermined time intervals; and synchronizing the filter control data stored on the client personal computer to the filter control data stored on the server when a difference is detected between there between. Pivowar disclosed a method for comparing information of the client and the sever and to synchronized the information when a difference is detected (col.1, lines 29-32, 36-42, col.5, lines 5-24, 40-52, col.10, lines 13-17, 36-41, col.12, lines 3-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan, Moon and Pivowar because Pivowar's teaching of synchronizing information and conflict resolution enables Narasimhan and Moon's method to ensure the system to have a set of completely updated information (see Pivowar: col.1, lines 56-62). Narasimhan, Moon and Pivowar did not disclosed in detail that the synchronization is performed at predetermined time interval. However, the concept and advantage of triggering commands or events using pre-set interval is well known and expected in the art (for example, daily scheduled virus scan, weekly meeting reminder prompting). It would have been obvious to one of ordinary

skill in the art at the time the invention was made to combine the teachings of Narasimhan, Moon and Pivowar and further schedule regulated times for synchronizing contents to maintain an updated set of information.

16. As per claims 7-8, Narasimhan taught the invention substantially as claimed including a method of forwarding email, comprising:

- m. Obtaining filter control data (col.1, lines 46-49, col.2, lines 3-6);
- n. Examining email data against the filter control data (col.5, lines 3-17); and
- o. Determining based on the examination the email data that should not be forwarded (col.2, lines 3-6, col.5, lines 3-23);
- p. Generating receipt data identifying the email data that should be forwarded (col.1, lines 46-51, col.4, lines 6-11, col.6, lines 11-18);
- q. Forwarding the receipt data via a computer network to a datastore associated with the server (col.4, lines 6-11, col.6, lines 11-21, 40-56).

17. Narasimhan did not specifically teach the method is instructed by a computer program downloaded from a server computer system to a client personal computer and to generate receipt data identifying the email data that should not be forwarded. Instead, Narasimhan taught to generate receipt data identifying the email data that should be forwarded (col.1, lines 46-51, col.4, lines 6-11, col.6, lines 11-18) and forward the receipt data via a computer network to a database (col.6, lines 19-21, 40-56). However, it would have been obvious that by identifying the email data that should be forwarded is equivalent to identify the email data that should not be

forwarded and it would have been obvious to download software and implement the server with an email forwarding application to forward the incoming email events to another device. Moon taught to forward the forwarded information to a remote device (col.2, lines 22-29) and to identify the email data that should not be forwarded and send the email data that should not be forwarded back to the server (col.2, lines 30-40, col.6, lines 16-20, col.7, lines 22-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon because Moon's teaching of identifying the email data that should not be forwarded enables Narasimhan's email system to be aware of which email messages to filter or block. Narasimhan and Moon did not specifically teach to compare the filter control data stored on the client personal computer with filter control data stored on the server at predetermined time intervals; and synchronizing the filter control data stored on the client personal computer to the filter control data stored on the server when a difference is detected there between. Pivowar disclosed a method for comparing information of the client and the sever and to synchronized the information when a difference is detected (col.1, lines 29-32, 36-42, col.5, lines 5-24, 40-52, col.10, lines 13-17, 36-41, col.12, lines 3-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan, Moon and Pivowar because Pivowar's teaching of synchronizing information and conflict resolution enables Narasimhan and Moon's method to ensure the system to have a set of completely updated information (see Pivowar: col.1, lines 56-62). Narasimhan, Moon and Pivowar did not disclosed in detail that the synchronization is performed at predetermined time interval. However, the concept and advantage of triggering commands or events using pre-set interval is well known and expected in the art (for example,

daily scheduled virus scan, weekly meeting reminder prompting). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan, Moon and Pivowar and further schedule regulated times for synchronizing contents to maintain an updated set of information.

18. As per claims 31, 34, 37, 39, 41, 43 and 45-46, Moon further taught that the client personal computer is protected by a firewall (figure 1: 18; col.3, lines 61-63, col.4, lines 45-46).

19. As per claims 32, 35, 42 and 44, Narasimhan, Moon and Pivowar did not specifically teach that the downloaded software self-installs. However, the concept and advantage of self-installing programs is well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan, Moon and Pivowar and further self-install the downloaded programs to reduce user intervention and provide user-friendly installation process of software.

20. As per claims 33, 36, 38 and 40, Narasimhan further disclosed that the email event includes emails (col.2, lines 1-3).

Response to Arguments

21. Applicant's arguments with respect to claims 1-8 and 31-46 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kenny S Lin/
Primary Examiner, Art Unit 2152
November 4, 2008